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09/214,840	01/13/99	HAMMER	K 051009/0114

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EXAMINER

FIGUEROA, J.

ART UNIT	PAPER NUMBER
1772	5

DATE MAILED:

06/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

- Office Action Summary	Application No. 09/214,840	Applicant(s) Hammer et al.
	Examiner John J. Figu roa	Group Art Unit 1772

Responsive to communication(s) filed on _____

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-13 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

Claim(s) _____ is/are allowed.

Claim(s) 1-3 and 11 is/are rejected.

Claim(s) 4-10, 12, and 13 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 5

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed on 2/19/99 and 9/3/99 are acknowledged.

However, there was no available English translation of Documents DE 4,439,149A, EP 718,406A and FR 1,546,629A. Thus, since a concise explanation of the relevance in English were not included of said patents which are not in the English language, they have been considered only to the extent that they have been cited in the International Search Report of October 22, 1997.

Claim Objections

2. Claims 4-10 and 12-13 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 4-10 and 12-13 have not been further treated on the merits.

Examiner wishes to point out that claim 12, although not itself actually a multiple dependent claim, depends on claim 9 which is an improper claim since it is a multiple dependent claim which depends on another multiple dependent claim.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because it is ambiguous from base claim 1 as to what the clause "which comprises transversely stretching the film by blow molding ..." is limiting. In other words, it is unclear from the claim language as to what it is exactly that "comprises transversely stretching the film by blow molding ..."

5. Claims 2-3 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

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exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 2 and 3 recite the broad recitations "7-15%", "300 to 700" and "plasticizer" respectively, while the claims subsequently also recite "*preferably* 9-12%", "*preferably* 400 to 600" and "*preferably* glycerol" respectively which are the narrower statements of said range/limitations.

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble "[t]he film as claimed in one or more of claims 1" is vague and unclear.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholson (US 5,277,857 A).

Applicant's claimed invention apparently is drawn to a seamless tubular cellulose-based film obtained from extruding a cellulose, N-methyl-morpholine N-oxide (NMMO) and water solution through a die, treating the film in an NMMO bath and subsequently transversely stretching the film by blow molding in an air section. Claims 2-3 and 11 recite, *inter alia*, the cellulose content in the film-forming solution to be 7-15%, the mean degree of polymerization for the cellulose to be between 300 and 700 and the film treated with a plasticizer such as glycerol.

Nicholson discloses seamless tubular cellulose food film casings derived from extruding a nonderivatized cellulose solution comprising cellulose pulp and an amine solvent, such as NMMO, which is further treated with a plasticizer such as glycerine (glycerol). (See Abstract; col. 3, line 51 to col. 4, line 37)

Moreover, Nicholson discloses a method for forming said seamless tubular film casings comprising providing a solution comprising cellulose and NMMO, extruding a seamless tube, passing said seamless tube from an annular orifice through an air gap into a non-solvent liquid bath and subsequently removing said tubular film from said liquid bath to attain a resultant seamless tubular film casing. (col. 4, line 50 to col. 5, line 13)

Furthermore, Nicholson discloses that it is well known in the art to produce cellulose food casings as seamless tubes derived from extruding solutions comprising cellulose,

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plasticizers and NMMO. (*See Background of the Invention, col. 1, line 11 to col. 3, line 49*)

Particularly, Nicholson discloses that the usual percentage of cellulose in these NMMO solutions is 10-35%. (col. 2, line 66 to col. 3, line 14)

Nicholson also discloses the non-derivatized cellulose to be have a high molecular weight between 80,000 to 150,000 since the process for forming the cellulose does not affect the degree of polymerization. Consequently, according to Nicholson, the mean degree of polymerization of the non-derivatized cellulose remains within a constant range irrespective of the process of its formation.

Nevertheless, a process limitation, such as the variance in the mean degree of polymerization in the formation of the reactant cellulose, regarding a subcomponent (cellulose) of a claimed resultant product (the tubular film) is not relevant regarding the issues concerning patentable distinctiveness of the resultant product itself over the prior art.

Nicholson discloses the claimed tubular film except for specifically disclosing all of Applicant's recited product-by-process limitations. However, the *method* of producing an article, such as a tubular film, is not germane to the issue regarding the patentability of the *article* itself. Thus, these product-by-process limitations need not been accorded any patentable weight.

The reference reads on the claims.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (703) 305-0582. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. The Examiner can also be reached on alternate Fridays.

If the attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization where this application is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose phone number is (703) 308-0661.


Ellis P. Robinson
Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700

jjf 

May 31, 2000